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REMARKS

Claims 1-20 are pending in the Application, with claims 15-20 newly added by amendment. Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S.P.N. 5,991,737 to Chen ("Chen"). In view of the amendments and Remarks, the Applicant respectfully requests reconsideration and allowance of the pending claims.

Rejections Under 35 U.S.C. §103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, (Fed. Cir. 1991).

Independent Claim 1

Claim 1 has been amended to recite "said request including at least a portion of said content." Support for the amendment can be found in the Application as-filed at least on page 9, line 13 to page 10, line 21, and claim 4.

Chen at column 4, lines 9-17 discloses:

Consumer 24 views, listens, feels, or experiences the media content received by consumer receiver 16, and if consumer 24 wishes to respond to the broadcast information, the consumer interacts with consumer transmitter 18 to cause an order to be transmitted to processing station 22 that includes data specifying the broadcast information (for example, specifying a particular radio or television station or the ID of a billboard), without specifying the content of the broadcast information. (Emphasis added).

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As seen above, Chen discloses a consumer order which explicitly excludes the content of the broadcast information. In contrast, claim 1 recites a request which includes a portion of the content. Thus, the Applicant respectfully asserts that claim 1 is allowable for at least the reason that Chen does not teach or disclose a request which includes a portion of the content as recited in claim 1.

To establish a prima facie case of obviousness, there must be a motivation or suggestion to combine the cited references and arrive at the claimed invention. In re Vaeck, 947 F.2d 488, 493 (Fed. Cir. 1991). References cannot be combined where a reference teaches away from the claimed invention. See M.P.E.P. § 2145, § 2143.01, and § 2141.02; In re Grasselli, 713 F.2d 731, 743 (Fed. Cir. 1983). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In Re Gurley, 27 F.3d 551, 533 (Fed. Cir. 1994). Further, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308 (Fed. Cir. 1999); M.P.E.P. § 2143.01.

As discussed above, Chen discloses a consumer order which explicitly excludes the content of the broadcast information. The Applicant respectfully asserts that one of ordinary skill in the art, when considering Chen, would be led away from a request which includes at least a portion of the content as recited in claim 1. Thus, claim 1 is allowable for at least the reason that Chen is not a proper obviousness reference because Chen expressly teaches away from the method of claim 1. For the same reason, claim 1 is allowable because one of skill in the art would not have the required reasonable expectation of success.

Dependent Claims 2-3

Claims 2 and 3 are allowable for at least the reason that each depends from an allowable claim, and for at least the reasons given for the allowability of claim 1.

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Independent Claim 4

Claim 4, which has not been amended, provides a method for conducting a transaction, and recites a request which includes an electronic representation of a recorded sample of audible content. The Applicant respectfully asserts that claim 4 is allowable for at least the reason that the Office Action does not address a request including a representation of a sample of audible content as recited in claim 4. Claim 4 is also allowable for at least the reasons given for the allowability of claim 1.

Dependent Claims 5-7

Claims 5 and 7 are allowable for at least the reason that each depends from an allowable claim, and for at least the reasons given for the allowability of claim 4.

Independent Claim 8

Claim 8, as currently amended, recites a system for conducting a transaction, and includes an electronic device having a request indicator that initiates a request which includes at least a portion of the content. Support for the current amendment exists in the Application as filed at least on page 9, line 13 to page 10, line 21, and claim 4. The Applicant asserts that claim 8 is allowable for at least the reasons given for the allowability of claim 1.

Dependent Claims 9-14

Claims 9-14 are allowable for at least the reason that each depends from an allowable claim, and for at least the reasons given for the allowability of claim 8.

Independent Claim 15

Claim 15 has been newly added by amendment, and provides a method for facilitating a transaction. Claim 15 recites elements from independent claims 1 and 4, and so has adequate support for at least the reasons that claims 1 and 4 have support. Similarly, claim 15 is allowable for at least the reasons given for the allowability of claims 1 and 4.

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Dependent Claim 16

Claim 16 depends from claim 15, and further recites wherein the representation includes at least a portion of the sample. Claim 16 has adequate support for at least the reasons given for the support of claim 15. Claim 16 is also allowable for at least the reason that it depends from allowable claim 15, and for at least the reasons given for the allowability of claim 15.

Dependent Claim 17

Claim 17 depends from claim 15, and further recites wherein the representation includes a digital hash generated using the sample. Claim 17 has support in the Application as-filed at least on page 13, lines 23-27, and page 14, lines 16-22.

The Applicant respectfully asserts that claim 17 is allowable for at least the reason that Chen does not teach or disclose the method of claim 15 wherein the request includes a digital hash generated using the sample. Claim 17 is also allowable for at least the reason that it depends from allowable claim 15, and for at least the reasons given for the allowability of claim 15.

Dependent Claim 18

Claim 18 depends from claim 15, and adds a step for determining the deliverable using a broadcast schedule. Claim 18 has support in the Application as-filed on at least page 13, line 17 to page 14, line 4, and page 15, line 24 to page 16, line 19.

The Applicant respectfully asserts that claim 18 is allowable for at least the reason that Chen does not teach or disclose the method of claim 15 further comprising a step for determining the deliverable using a broadcast schedule. Claim 18 is also allowable for at least the reason that it depends from allowable claim 15, and for at least the reasons given for the allowability of claim 15.

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Dependent Claim 19

Claim 19 depends from claim 15, and adds a step for determining the deliverable by comparing the representation with content in a database. Claim 19 has support in the Application as-filed on at least page 13, line 17 to page 14, line 4, and page 15, line 24 to page 16, line 19.

The Applicant respectfully asserts that claim 19 is allowable for at least the reason that Chen does not teach or disclose the method of claim 15 further comprising the step of determining the deliverable by comparing the representation with content in a database. Claim 19 is also allowable for at least the reason that it depends from allowable claim 15, and for at least the reasons given for the allowability of claim 15.

Dependent Claim 20

Claim 20 depends from claim 15, and adds a step for determining the deliverable by manual review. Claim 20 has support in the Application as-filed on at least page 14, lines 2-4, and page 16, line 20 to page 17, line 2.

The Applicant respectfully asserts that claim 20 is allowable for at least the reason that Chen does not teach or disclose the method of claim 15 further comprising the step of determining the deliverable by manual review. Claim 20 is also allowable for at least the reason that it depends from allowable claim 15, and for at least the reasons given for the allowability of claim 15.


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CONCLUSION

In view of the foregoing Remarks and amendments, the Applicant respectfully request reconsideration of the rejections and allowance of the pending claims. No additional fee is believed due. However, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully Submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence and any items indicated as attached or included, are being transmitted via facsimile transmission to: Examiner Knepper, David D., Art Unit 2654, (571) 273-8300, on the date indicated below.


Jason S. Jackson

July 26, 2006
Date